

REMARKS

1. Claims 1-25 were filed in this application, and Claims 7-25 have been withdrawn by the Examiner in a restriction requirement.

2. Applicant has amended Claim 6 to correct the antecedent basis error that was pointed out by the Examiner. Applicant has also amended Claim 1, for which support is found at least in the application as filed in paragraph [0020] as filed. No new matter was entered in making the amendments to Claims 1 and 6.

3. Applicant traverses the rejection of Claims 1-6, because the references do not teach or suggest, singly or in combination, the limitations of the claims. As noted in the rejection, U.S. Pat. No. 4,803,091 to George Mottur et al. (Mottur) and U.S. Pat. No. 4,806,377 to Eugene Ellis et al. (Ellis), teach a planar chip. The references to planar chips, however, are barely made as these inventors quickly pass to their inventions of shaped products. Mottur, for instance, teaches "corn spirals and method of manufacture," see title, while Ellis teaches and claims a snack food that is formed into a ribbon, a collet, a pellet or a chip. Ellis, col. 3, lines 41-43, and col. 10, lines 1-3. The secondary reference, U.S. Pat. No. 5,188,859, to Richard Lodge et al. (Lodge) also does not teach the desirability of planar chips, since the "ovals" in the rejection are actually three-dimensional, saddle-shaped "Pringle's" type chips, as seen in the side view of Fig. 2 of the molds of Fig. 1, also seen on the first page of Lodge. None of these references teaches or suggests a minimum size of about eight square inches.

In order to make out a prima facie case of obviousness, the references must teach or suggest all the limitations of the claims and must suggest the desirability of the claimed invention. M.P.E.P. 2143.01 and 2143.03. Mottur mentions that prior art "corn chips and potato chips are generally planar, concave, or ridged," col. 1, lines 12-13, but then teaches that more desirable snack foods are made by better grinding of the masa, subsequent formation into a ribbon-like sheet, and extrusion into a spiral shape. Col. 1, lines 49-65. This suggests that a spiral shape is desirable, not a planar shape. Therefore, Mottur does not teach or suggest the desirability of the invention of Claim 1.

As for the argument of routine experimentation to determine the size of the chip, the embodiments of Applicant's invention feature the novel application of a vegetable chip in the size of a piece of bread, i.e., a "sandwich-sized" chip. That is, embodiments of Applicant's invention are a combination of a planar chip with the size of a piece of bread. The argument

that "routine experimentation" would determine the optimum size of the chip is the essence of hindsight, because the argument assumes an idea, a chip the size of a piece of bread, which did not exist before Applicant's invention. The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention. M.P.E.P. 2141.

Mottur and Lodge

Combining Mottur with Lodge also fails to make a prima facie case for obviousness. The rejection cites Lodge for the perforation limitation of Claim 5. As noted above, however, Lodge teaches the use of saddle shaped molds, not a flat or planar shape. Neither teaches nor suggests a minimum size of about eight square inches. Thus, Mottur alone, or the Mottur and Lodge combination, does not teach or suggest the limitations of Claim 1 or Claim 5.

Ellis and Lodge

Ellis teaches waxy corn masa based products, but does not teach that the products have a minimum size of about eight square inches, as required by Claim 1. Combining Ellis with Lodge would suggest extruding corn masa into Lodge's saddle-shaped molds, to make regular, saddle-shaped chips, perhaps similar to "Pringle's" potato chips. Thus, neither Ellis, nor the combination of Ellis and Lodge, teaches the limitations recited in Claim 1 or Claim 5.

The rejection further argues that finding the optimum area of the chips as well as the optimum thickness and oil content, as recited in Claims 1, 4 and 6, would require nothing more than routine experimentation by one reasonably skilled in the art. Applicant traverses this assertion. In order to make out a prima facie case of obviousness, the references must teach or suggest all the limitations of the claims. M.P.E.P. 2143. In this instance, the prior art cited does not teach or suggest vegetable chips with the following: a minimum size of about eight square inches, as recited in Claim 1; a thickness of from about 0.025 to about 0.10 inches thick, as recited in Claim 4; and an oil content from about two percent to about forty percent, as recited in Claim 6. In order to sustain a rejection for obviousness, there must be some concrete evidence to support the rejection. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (reversing rejections for obviousness because there was no substantial evidence to support the rejection).

4. The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

U.S. Pat. Appl. 10/677,013
Office Action mailed May 25, 2006
Response transmitted July 10, 2006

Attorney Docket No. 505497

Examiner, a telephone conference would expedite the prosecution of the subject application,
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. W. Okey", is written over a horizontal line.

David W. Okey, Reg. No. 42,959
Reinhart Boerner Van Deuren P.C.
483 N. Mulford Road, Suite 7
Rockford, Illinois 61107
(815) 484-1900 (telephone)
(815) 484-1032 (facsimile)

Date: July 10, 2006